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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/540,956

03/13/2006

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EXAMINER

KUMAR, VINOD

ART UNIT

PAPER NUMBER

1638

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/540,956	<b>Applicant(s)</b> TYAGI ET AL.	
	<b>Examiner</b> VINOD KUMAR	<b>Art Unit</b> 1638	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 15 February 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☒ Applicant's reply has overcome the following rejection(s): 35 U.S.C. 101.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: None.  
 Claim(s) objected to: None.  
 Claim(s) rejected: 35-45.  
 Claim(s) withdrawn from consideration: None.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
 13. ☐ Other: \_\_\_\_\_.

/Phuong T. Bui/  
 Primary Examiner, Art Unit 1638

Continuation of 11. does NOT place the application in condition for allowance because: Claims 35-45 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Mukhopadhyay et al. (NCBI/EMBL Database, Sequence Accession No. AF140722, Published June 7, 2000) in view of Hiel et al. (The Plant Journal, 6:271-282, 1994) and Liu et al. (Eur. J. Biochem., 262:247-257, 1999) for the reasons of record stated in the Office action mailed on June 27, 2007.

Applicant traverses the rejection in the paper filed on February 15, 2008. Applicant cites Kanneganti et al. to argue that OsiSAP1 is a cytoplasmic protein, not a transcription factor, and thus one skilled in the art would not know that OsiSAP1 would be implicated in plant's response to abiotic stresses. Applicant further argues that Liu et al. teachings cannot be extended to conclude that OsiSAP1 would have produced an abiotic stress tolerant transgenic plant. Applicant further argues that there is no motivation to combine Mukhopadhyay with Liu et al. to arrive at the instantly claimed invention. Applicant also argues that Liu et al. do not teach or suggest that an AN1/AN20 type zinc-finger gene would be involved in abiotic stress tolerance (response, page 5, lines 1-31).

Applicant's arguments were fully considered but were deemed to be unpersuasive. It is maintained that it would have been prima facie obvious to one of ordinary skill in the art at the time the claimed invention was made to transform a plant with Mukhopadhyay et al. polynucleotide sequence encoding a zinc finger motif(s) containing protein using any method of plant transformation including the rice plant transformation method taught by Hiel et al., to arrive at the instantly claimed invention with reasonable expectation of success. It is further maintained that given Mukhopadhyay et al. clearly teach that their protein is a zinc finger motif containing protein, and Liu et al. teach the role of zinc-finger motif containing proteins in abiotic stress tolerance, it would have been obvious and within the scope of an ordinary skill in the art at the time the claimed invention was made to overexpress Mukhopadhyay et al. sequence in any plant including an economically important rice plant to arrive at the instantly claimed invention with reasonable expectation of success. See recent Supreme Court decision in *KSR International Co. v. Teleflex inc.*, wherein KSR forecloses the argument that a specific teaching, suggestion or motivation is required to support a finding of obviousness. See the recent Board decision *Ex parte Smith*, -- USPQ2d --, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (citing KSR, 82 USPQ2d at 1396). In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would have arrived at the instantly claimed invention by combining the teachings of Mukhopadhyay et al., Hiel et al. and Liu et al. with reasonable expectation of success. Applicant is reminded that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In the instant case, one of ordinary skill in the art would have arrived at the claimed invention by combining the teachings of the cited art with reasonable expectation of success.

Accordingly, the rejection is maintained.